

REMARKS/ARGUMENTS

In the Office Action claim 7 was rejected under 35 USC § 112, second paragraph, as being indefinite. In particular, claim 7 depended from canceled claim 3. In this Amendment claim 7 has been amended to now depend from claim 1. It is submitted that the amendment to claim 7 overcomes the rejection under 35 USC § 112 and the Examiner is requested to withdraw this basis of rejection for the claim.

Claims 1, 2, 4, 6 and 8-19 were rejected under 35 USC § 103 (a) as being obvious over the Chen et al. '897 EP patent.

The Chen EP patent teaches a friction material having a fibrous base material comprising a porous primary layer and a secondary layer. The secondary layer comprises friction modifying particles comprising silica. The Examiner acknowledges that the Chen reference does not teach that the secondary layer comprises a mixture of 20-35% silica and 65-80% carbon. The Applicant's agree that the Chen references does not disclose or suggest this feature as defined in Applicant's claims. It is the Examiner's position that the invention defined by Applicant's claims would have been obvious in view of the teaching of the Chen EP reference. Further, the Examiner states that it would have been obvious to select the appropriate amounts of the two friction modifying particles through the process of routine experimentation to obtain the optimum friction properties.

The Chen EP patent is owned by the same assignee as the assignee for this patent application. The inventors on the EP reference are two of the inventors listed on the instant application along with an additional inventor employed by the assignee. I would also like to point out that the Chen '897 EP patent is the European equivalent of the Lam '416 patent relied upon by the Examiner in later portions of the Office Action. In the specification for this invention it was clearly stated that considerable research was necessary to maximize the friction material to obtain the desired properties. In addition, the performance characteristics required in a friction material are constantly changing and the properties of the

friction material must be continuously enhanced to meet the increased performance demands required by new applications in the automotive industry. The specific limitations in the claims concerning the friction modifying particles was not obvious at the time of the invention as the advantages of this combination is not taught or suggested in the Chen EP reference relied upon by the Examiner. In addition, the performance requirements that are satisfied by the current invention are different than the performance requirements that were the target when the technology covered by the Chen EP patent was developed. In addition, if the present invention was obvious, the common inventors from the Chen EP patent would not have needed to conduct extensive research to develop the present invention. It is the Applicant's position that the invention defined by the claims is not taught or suggested by the Chen EP reference and that the friction material of the Chen EP reference would not satisfy the performance requirements now required by friction material for new applications. Accordingly, the Examiner is respectfully requested to withdraw this basis of rejection for the claims.

Claims 1, 2, 4, 6 and 8-19 were rejected under 35 USC § 103 (a) as being obvious over the Lam '307 patent in view of the Chen '897 EP patent. The Lam reference teaches a friction material having a fibrous base material comprising a porous primary layer and secondary layer. The secondary layer is comprised of carbon friction modifying particles. The Examiner acknowledges that the Lam patent does not teach that the secondary layer comprises a mixture of 20-35% silica and 65-80% carbon as set forth in Applicant's claims. Accordingly, the Lam reference has the same deficiency as the previously discussed Chen EP reference. Again in this rejection the Examiner is contending that it would have been obvious for one to combine the teachings of the Lam reference with the Chen reference to get the specific mixture of friction modifying particles set forth in Applicant's claims. As set forth in the response to the previous basis for rejection these claims the inventors of the Lam '307 patent overlap with the inventors listed on the present application. As set forth in the present application considerable research was

necessary to quantify the types and quantities of friction material particles that would be suitable to satisfy the performance characteristics require for current applications of friction materials. These performance requirements did not exist at the time that the invention covered by the Lam '307 patent was made. It is the Applicant's position that the Lam '307 patent does not provide the deficiencies of the previous discussed Chen EP patent and that these references, taken individually or in combination, do not disclose or suggest the invention defined by Applicant's claims. Accordingly, the Examiner is respectfully requested to withdraw this basis of rejection for the claims.

The Examiner also makes some comments with regard to specific dependent claims that depend either directly or indirectly from claim 1. However, it is the Applicant's position that the entire invention defined by these dependent claims is not shown in the references relied upon by the Examiner. In fact, the Examiner has acknowledged that neither the Lam or the Chen EP patent teach the specific mixture of silica and carbon friction particles set forth in the Applicant's claims. Accordingly, it is the Applicant's position that the specific dependent claims mentioned by the Examiner define an invention that is not disclosed or suggested by the Lam or Chen EP patent.

Claims 1, 2, 4, 6 and 8-19 were rejected under 35 USC § 103 (a) as being obvious over Chen and Lam references. This appears to be a repeat of the rejection that was set forth in paragraph 3 of the Office Action and it is the Applicant's position that it has already addressed the issues with regard to a rejection over the Chen EP patent and the Lam '307 patent. However, it was not entirely clear which Lam reference was covered in this rejection. If the Examiner intended to refer to the Lam '416 patent instead of the Lam '307 patent the Applicant's would like to point out that the Lam '416 patent and the Chen '897 EP patent are the same references. As such, it is the Applicant's position that the Lam '416 patent has the same deficiency as the previously discussed Lam '307 and Chen EP patents that have previously been dealt with in this Amendment.

Accordingly, it is the Applicant's position that the claims patentably distinguish over the Chen EP and Lam '416 patents and the Examiner is respectfully requested to withdraw this basis of rejection, if in fact that is the basis of rejection that is set forth in paragraph 6.

Claims 1, 2, 4, 6 and 8-19 were rejected under 35 USC § 103 (a) as being unpatentable over the Lam et al. '416 patent as applied under 35 USC § 102 (f).

With respect to the '416 patent, the Examiner again acknowledges that the reference is silent with respect to the amount of silica and carbon particles used in the friction modifying layer of the friction material. In this Amendment and the previous Amendment the Applicant's have pointed out the significance of the limitations contained in the claims and that these limitations are not taught or suggested by the Lam '416 patent. It is still the Applicant's position that the claims are patentably distinct over the Lam '416 patent.

The Examiner also indicated that the Lam '416 patent is prior art under 35 USC § 102 (f). Section 102 (f) states "he did not himself invent the subject matter sought to be patented". The inventors on the Lam '416 patent are two of the three inventors listed on the present patent application. In addition the Examiner has acknowledged that the Applicant has provided evidence that the Lam '416 patent and the present patent application are owned by the same assignee. With significant overlap in inventorship and the fact that there is common ownership for the '416 patent and this patent application it is not seen how the Examiner can take the position that the invention covered by the claims of this patent application were not invented by the listed inventors under 35 USC § 102 (f). Accordingly, it is not seen how the Lam '416 patent additionally qualifies as additional prior art under 35 USC § 102 (f). It is the Applicant's position that § 102 (f) is not being properly applied with respect to the Lam '416 patent and the Examiner is respectfully requested to withdraw this basis of rejection for the claims.

Claim 1, 2, 4, 6 and 8-19 were rejected on the grounds of nonstatutory obviousness-type double patenting over the Lam '416 patent. To respond to this

basis of rejection the Applicant's have attached a Terminal Disclaimer, the '416 patent and it is submitted that this Terminal Disclaimer overcomes this basis of rejection for the claims and removes the '416 from consideration as a prior art reference. The Lam '416 patent is the priority application on which the Chen '897 EP patent is based. Accordingly, the Lam '416 patent and the Chen '897 EP patent are the same patent document. It is submitted that the Terminal Disclaimer filed in the application also removes the Chen '897 EP patent from being considered as prior art.

In view of the amendments to the claims and the arguments and distinctions contained herein, it is the Applicant's position that the claims are patentably distinct over the prior art relied upon by the Examiner. Accordingly, a favorable action on the claims is respectfully requested.

Respectfully submitted,
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